

REMARKS

Claim 31 has been amended by incorporating the subject matter of claim 35 into it. Accordingly, claim 35 has been canceled.

Claims 54 and 55 have been amended so that these claims, like claim 56, are directed to a mascara. Support for this amendment exists throughout the present specification.

Claims 31-34 and 36-61 are currently pending, although claims 57-61 have been withdrawn from consideration. Upon indication of allowable subject matter, Applicants currently intend to seek appropriate rejoinder of the withdrawn claims.

The Office Action rejected claims 54 and 55 under 35 U.S.C. §112, second paragraph. Although Applicants disagree with this rejection (for example, a topcoat composition could be applied to an eyelash on top of mascara which has already been applied to the eyelash), to expedite prosecution in this case Applicants have amended claims 54 and 55 so that they are directed to a mascara. Applicants respectfully submit that these amendments have rendered the §112 rejection moot, and that this rejection should be withdrawn.

The Office Action also rejected claims 31-44, 46 and 50-54 under 35 U.S.C. §102 as anticipated by U.S. patent 7,129,276 (“Ferrari”), and claims 31-42, 44-47 and 50-54 under 35 U.S.C. §102 as anticipated by U.S. patent application publication no. 2003/0165451 (“Lennon”). The Office Action also rejected claims 47 and 48 under 35 U.S.C. §103 as obvious over Ferrari or Lennon in view of U.S. patent 5,876,704 (“Collin”). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

Regarding the §102 rejections, the pending claims relate to compositions comprising at least 45% solid content, 10-60% fatty phase and no waxes. Neither Ferrari nor Lennon discloses the claimed compositions.

For example, Lennon does not disclose compositions containing at least 45% solid content. The specification does not teach this requirement, and the exemplified compositions all have less than 45% solid. Nowhere does Lennon disclose a composition, particularly a mascara, having at least 45% solid content, 10-60% fatty phase and no waxes.

Similarly, Ferrari does not disclose compositions containing 10-60% fatty phase. The specification does not teach this requirement, and the exemplified compositions all have more than 60% fatty phase. Nowhere does Ferrari disclose a composition, particularly a mascara, having at least 45% solid content, 10-60% fatty phase and no waxes.

Because neither Ferrari nor Lennon discloses compositions having all of the required elements, neither of these references can anticipate the claimed invention.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §102.

Regarding the §103 rejection, at the time the present invention was made, the present invention (and, thus, the present application), Ferrari and Lennon were owned by, or subject to an obligation of assignment to, L'Oréal. Accordingly, Ferrari and Lennon are not available as prior art under 35 U.S.C. § 103(c). See, MPEP 706.02(1). Applicants respectfully submit that because Ferrari and Lennon are not available as prior art, the pending rejections based upon Ferrari and Lennon cannot stand and, thus, should be withdrawn.

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Furthermore, the remaining reference, Collin, neither teaches nor suggests the claimed invention. Collin is merely cited for its disclosure relating to the use of specific film forming polymers in mascara, and does not teach or suggest compositions having at least 45% solid content, 10-60% fatty phase and no waxes.

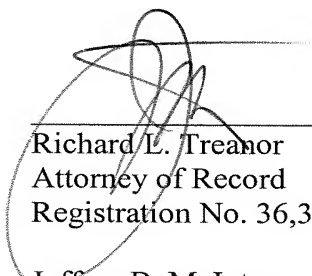
In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §§102 and 103.

Finally, to perfect priority in this case, Applicants submit herewith a certified English translation of the French priority application.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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